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**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application Number: 10/810,512
Filing Date: March 26, 2004
Appellant(s): TIGHE ET AL.

Kurt M. Pankratz
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 08-30-2010 appealing from the Office action mailed 04-01-2010.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application: 1-22, 24-26, and 33-39.

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being

maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

**(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

**(8) Evidence Relied Upon**

| | |
|---|---|
| Bales et al: | US 5,574,724 |
| Schroderus: | US 2003/00223381 |
| Bowman-Amuah: | US 6,434,568 |

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-8, 10-17, 19, 20, 22, 24-26, and 33-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bales et al (US 5,574,724), hereinafter referred to as Bales) in view of Schroderus (US 2003/0223381).

5. Regarding claims 10, 35 and 39. Bales discloses a method for supporting communications comprising: establishing a packet-based audio communication link with a remote device (see fig.1, a packet based audio communication link is established between terminals 106 and 107 through multiple nodes 101-104 using links 111-119); informing a local computing device of the audio communication link (all the network elements within fig.1 are aware of the communication link); receiving a message from the local computing device, the message requesting identification of enhanced media capabilities associated with the remote device (see col.3, lines 32-60. enhanced media capability message is transmitted); receiving a response in the audio communication

link from the remote device (see col.3, lines 32-60. enhanced media capability response message is received), the response identifying the enhanced media capabilities associated with the remote device (the response indicated the type of media capability); and forwarding the response to the local computing device (response is forwarded to al the network element within the network figs.1 and 2).

6. Bales discloses all the limitations of the claimed invention with the exception of tunneling request and response messages in the audio link. However, Schroderus, from the same field of endeavor, discloses a method of embedding signaling messages in real time data traffic (see at least paragraph [0011]). Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention employ the method of embedding signaling messages into real time traffic, as taught by Schroderus, into the communication system of Bales from the purpose of saving network resources (as suggested by Schroderus).

7. Regarding claims 1. Bales discloses a method for supporting communications comprising: establishing a packet-based audio communication link between a telephony device and a remote device (see fig.1, a packet based audio communication link is established between terminals 106 and 107 through multiple nodes 101-104 using links 111-119); informing a local computing device coupled to the local telephony device of the audio communication link (all the network elements within fig.1 are aware of the communication link); receiving a message from the local computing device, the message requesting identification of enhanced media capabilities associated with the remote computing device coupled to the remote telephony device (see col.3, lines 32-

60. enhanced media capability message is transmitted through all the nodes 101-104); receiving a response in the audio communication link from the remote device (see col.3, lines 32-60. enhanced media capability response message is received), the response identifying the enhanced media capabilities associated with the remote device (the response indicated the type of media capability); and forwarding the response to the local computing device (response is forwarded to al the network element within the network figs.1 and 2).

8. Bales discloses all the limitations of the claimed invention with the exception that the remote device forwards the message to the remote telephony device and forwards the response from the remote telephony device to the computing device. however, it would have been obvious as a matter of design choice to combine the remote telephony device with the last switch node as one device for the purpose to minimize network hardware.

9. Bales discloses all the limitations of the claimed invention with the exception of tunneling request and response messages in the audio link. However, Schroderus, from the same field of endeavor, discloses a method of embedding signaling messages in real time data traffic (see at least paragraph [0011]). Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention employ the method of embedding signaling messages into real time traffic, as taught by Schroderus, into the communication system of Bales from the purpose of saving network resources (as suggested by Schroderus).

10. Regarding claims 2, 11, and 36. Bales discloses a communication method, which further comprises determining, at the local computing device, whether the enhanced media capabilities associated with the remote device include a particular enhanced media capability; and communicating enhanced media packets to the remote device in response to determining that the enhanced media capabilities associated with the remote device include the particular enhanced media capability (column 3, lines 35-60. Based on the acknowledgment received, the system determines if the system may or may not support a video communication. If it may, the system initiates the video communication).

11. Regarding claims 3, 12, 24 and 37. Bales discloses a communication method wherein the particular enhanced media capability is a video capability (column 3, lines 35-60. The media capability is a video capability), the enhanced media packets are video packets (figure 1 is a packet switching network), and communicating the enhanced media packets to the remote device comprises tunneling the video packets in the audio communication link to the remote device (See Schroderus: at least paragraph [0011]).

12. Regarding claims 4, 13, 25 and 38. Bales discloses a communication method wherein the particular enhanced media capability is a video capability (column 3, lines 35-60. The media capability is a video capability), the enhanced media packets are video packets (figure 1 is a packet switching network), and communicating the enhanced media packets to the remote device comprises communicating the video

packets in a second communication link to the remote device (column 3, lines 62-67. the audio channel and video channel are different channels).

13. Regarding claims 5, 14 and 26. Bales disclose a communication method that further comprises receiving enhanced media packets from the remote device and automatically displaying (figure 1. 101 is connected to a displaying device 106 to display incoming video from the 104), at the computing device, at least one enhanced media window in response to receiving the enhanced media packets from the remote device (106 is interpreted as a displaying device. Inherently, displaying a video will require the usage of a media window).

14. Regarding claims 6 and 15. Bales discloses a communication method wherein the particular enhanced media capability is an instant-messaging capability (column 3, lines 5-67. The media capability includes audio video capability. Audio video communication between at least two users is considered an instant messaging), the enhanced media packets are instant-messaging packets (fig.1. The system is packet based system), and communicating the enhanced media packets to the remote device comprises tunneling the instant-messaging packets in the audio communication link to the remote device (See Schroderus: at least paragraph [0011]).

15. Regarding claims 7 and 16. Bales discloses a communication method wherein the audio communication link uses Real-time Transport Protocol (RTP) ((See Schroderus: at least paragraph [0053]).

16. Regarding claims 8 and 17. Bales discloses a communication method that further comprises halting communications on the audio communication link; and informing the

local computing device of the halting of communications on of the audio communication link (column 3, lines 5-32. the user establishes the communication link through 101. it is inherent for the user to stop the link established trough 101).

17. Regarding claims 19 and 22. Bales discloses a communication support apparatus. The apparatus comprises an interface operable to couple to a local computing device and a packet network (figure 1, 101 and 106); and a controller coupled to the interface (102), the controller operable to establish a packet-based audio communication link with a remote device (104), to inform the local computing device of the audio communication link (column 3, lines 5-32), to receive a message from the local computing device (column 3, lines 32-60, a messages is transmitted and received), the message requesting identification of enhanced media capabilities associated with the remote device(104 receives a message regarding media capability associated with it), to receive a response in the audio communication link from the remote device column 3, lines 35-60. The system receives an acknowledgment regarding the transmitted request), the response identifying the enhanced media capabilities associated with the remote device (column 3, lines 35-60. An acknowledgment is received regarding the media capability of 103), and to forward the response to the local computing device (101 receives an acknowledgment regarding the transmitted message).

18. Bales discloses all the limitations of the claimed invention with the exception of tunneling request and response messages in the audio link. However, Schroderus, from the same field of endeavor, discloses a method of embedding signaling messages in

real time data traffic (see at least paragraph [0011]). Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention employ the method of embedding signaling messages into real time traffic, as taught by Schroderus, into the communication system of Bales from the purpose of saving network resources (as suggested by Schroderus).

19. Regarding claim 20. Bales discloses an apparatus wherein the controller is further operable to tunnel enhanced media packets between the local computing device and the remote device in the audio communication link (See Schroderus: at least paragraph [0011]).

20. Regarding claim 33. Bales discloses a system supporting communications. The system comprises a packet-based telephony device operable to establish an audio communication link with a remote device (fig.1); and a local computing device (104) coupled to the telephony device (103); wherein the telephony device is further operable to receive a message (column 3, lines 32-60. 101 sends media capability request to 103), the message requesting identification of enhanced media capabilities associated with the local computing device (column 3, lines 32-60), to forward the message to the local computing device (figure 2, 203), to receive a response from the local computing device (207, 208, 209), the response identifying the enhanced media capabilities associated with the local computing device (column 3, lines 32-60), and wherein the computing device is further operable to receive the message (203), to generate the response (207), to receive enhanced media packets from the remote device (207), and to automatically display at least one enhanced media window in response to receiving

the enhanced media packets from the remote device (107, associated with 104, is a display device. 107 displays videos received from 101).

21. Bales discloses all the limitations of the claimed invention with the exception of tunneling request and response messages in the audio link. However, Schroderus, from the same field of endeavor, discloses a method of embedding signaling messages in real time data traffic (see at least paragraph [0011]). Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention employ the method of embedding signaling messages into real time traffic, as taught by Schroderus, into the communication system of Bales from the purpose of saving network resources (as suggested by Schroderus).

22. Regarding claim 34. Bales discloses a system wherein the enhanced media packets are video packets and the enhanced media window displays video images (column 3, lines 32-60. 101 and 104 exchange video packets, and 107 displays videos received from 101).

23. Claims 9, 18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bales in view Schroderus and further in view of Bowman-Amuah (US 6,434,568).

24. Bales discloses that halting communications on the audio communication link occurs after receiving an instruction from a user (column 3, lines 5-32. the user establishes the communication link through 101. it is inherent for the user to stop the link established trough 101).

25. Bales does not disclose that the instruction selected from a plurality of options comprising hold, transfer, and mute. However, Bowman-Amuah discloses a method

where the user has access to multiple instructions, such as holding, transferring, and muting (see column 61, lines 10-35). Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement the method implementing phone features through a computer, as taught by Bowman-Amuah, into the communication terminal of Bales for the purpose of enhancing the capabilities and features of video conferencing or instant messaging.

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

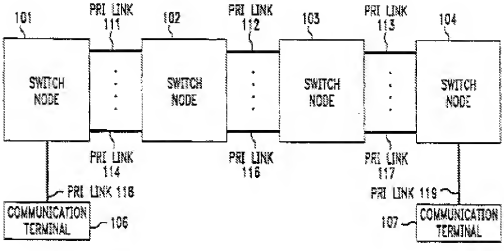
**(10) Response to Argument**

**A. Rejection under 35.U.S.C 103 (a): Claims 1-8, 10-17, 19-20, 22, 24-26, and 33-39 over Bales in view of Schroderus.**

Appellants argue that the prior art of record Bales in view of Schroderus failed to disclose (A) the claimed configuration of devices; (B) "receiving a message from the local computing device [coupled to the local telephony device] . . . requesting identification of enhanced media capabilities associated with a remote computing device [coupled to the remote telephony device]" and (C) "tunneling the message in the audio communication link to the remote telephony device,"

With respect to the first argument (A), examiner respectfully disagrees, as it can be seen the figure below (Bales: fig.1), Bales discloses a telephony device 106 in communication with a remote telephony device 107 through multiple computing devices (101-104) which are connected through communication links. Therefore, the argued claim configuration is taught by Bales.

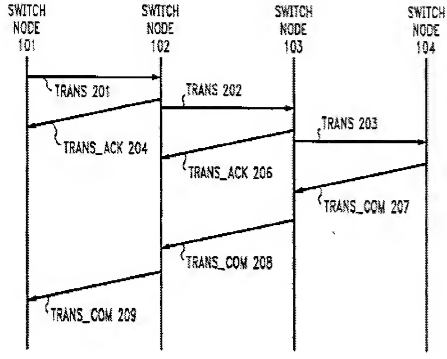
*FIG. 1*




**Bales et al: fig.1**

With respect to the second argument (B), examiner respectfully disagrees, as it can be seen from the figure and the paragraph below, Bales discloses a method wherein node 101 send a request to devices 102-104 requesting identification of media capabilities associated with nodes 102-104. Node 101 sends a request to add enhanced media capability to existing session and nodes within the network respond to the request by transmitting back a response TRANSmessages . Therefore, the argued limitations is taught by Bales

*FIG. 2*




**Bales et al: fig.2**

At a subsequent time, the users of communication terminals **106** and **107** desire a video capability so that they can exchange video images. Communication terminal **106** requests that switch node **101** add video capability to the call. Switch node **101** does this by transmitting TRANS **201** (transport) message as illustrated in FIG. **2** to switch node **102**. TRANS **201** message requests that a video capability be added to the call. (The actual contents of the message will be discussed in greater detail later.) If switch node **102** can provide the video capability, it transmits back TRANS ACK **204** message as illustrated in FIG. **2**. In addition, switch node **102** transmits TRANS **202** message of FIG. **2** to switch node **103**. This message also requests that a video capability be set up between switch node **102** and switch node **103**. Assuming switch node **103** is capable of providing the video capability, it transmits back to switch node **102** TRANSACK **206** message and transmits TRANS **203** to switch node **104**. If switch node **104** can provide the video bandwidth and communication terminal **107** has video capability, switch node **104** transmits to switch node **103** TRANS COM **207** message. This message is repeated back to switch node **101** via switch nodes **103** and **102**. If at a still later point in time, the user of communication terminal **106** desires that the video capability be eliminated, communication terminal **106** sends a message to switch node **101** requesting the elimination of the video capability. The messages illustrated in FIG. **2** are once more sent through the switch nodes. However, the TRANS messages now request that the video bandwidth be removed.

**Bales et al: Col.3, lines 32-60**

With respect to the third argument (c ), examiner respectfully disagrees, as previously indicated in the final rejection: " Bales discloses all the limitations of the claimed invention with the exception that the remote device forwards the message to the remote telephony device and forwards the response from the remote telephony device to the computing device. However, it would have been obvious as a matter of design choice to combine the remote telephony device with the last switch node as one

device for the purpose to minimize network hardware. Bales discloses all the limitations of the claimed invention with the exception of tunneling request and response messages in the audio link. However, Schroderus, from the same field of endeavor, discloses a method of embedding signaling messages in real time data traffic (see at least paragraph [0011]). Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention employ the method of embedding signaling messages into real time traffic, as taught by Schroderus, into the communication system of Bales from the purpose of saving network resources (as suggested by Schroderus)." Therefore, by combining the capabilities of 102-104 and 107, the remote telephony device will be able to receive the requests generated from the device 101. Moreover, with respect to the tunneling, Schroderus discloses a method of tunneling signaling messages in the real time data traffic for the purpose of transferring a request for an acknowledgement. Furthermore, with respect to the motivation, examiner has stated that the person of ordinary skill in the art would use Schroderus approach for the purpose of saving network resources. Interestingly, Schroderus clearly state that tunneling messages within the real time traffic makes it unnecessary to reserve another bearer for the control signaling therefore a bearers can be saved and used by the network for something else (see paragraph below).

[0011] In an embodiment of the invention, embedded (i.e. implicit) signalling in a real-time data traffic is employed for transferring a request for an acknowledgement report and/or the acknowledgement report(s). Embedded signalling makes it unnecessary to reserve another bearer for the control signalling, which saves network resources and allows a short connection setup time to be achieved. In another embodiment, the acknowledgement report(s) is transferred using outband signalling, such as SIP signalling.

**Schroderus: paragraph [0011]**

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Mounir Moutaouakil/

Examiner, Art Unit 2476

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